



**COURT OF FIRST INSTANCE,
MILAN LOCAL DIVISION**

**UPC_CFI_703/2025
- UPC_CFI_1757/2025**

**Order
issued on 21
July 2026**

KEYWORDS: judicial experiment, inspection, appointment of a court expert, powers and duties; delegated activities; Rules 185 and 186 of the Rules of Procedure (RoP); order for production under Rules 170.2(g) and 201 of the RoP; case management powers.

PLAINTIFF

PRiNOTH S.p.A.

represented and defended by the solicitors Renato Bocca, Stefano Grassini and Camilla Scalvini, and by the authorised representatives Mauro Eccetto and Angelo Cicchetti,

DEFENDANT

XELOM s.r.l.

represented and defended by Niccolò Ferretti, Gherardo Piovesana, Sergio Francini and Emanuela Grazia

PATENTS SUBJECT TO THE PROCEEDINGS

EP2507436

EP 1995159

DECIDING JUDGE

Alima ZANA, Reporting Judge, having heard the Panel

LANGUAGE OF THE PROCEEDINGS

Italian

Proceedings

1. On 24 February 2025, Prinoth S.p.A. (hereinafter referred to as 'Prinoth') lodged an appeal with the Milan Local Division of the Unified Patent Court against its competitor Xelom s.r.l. (hereinafter referred to as 'Xelom') seeking an order for the inspection, preservation and seizure of evidence *in the absence of the other party* pursuant to Article 60 of the UPCA and Rules 192 et seq. of the Rules of Procedure (RoP), in order to protect its patents EP'436 and EP'159.
2. On 18 March 2025, the Court issued the order requested by Prinoth (No. 11002/2025), appointing Mr Antonio Di Bernardo as Court Expert.
3. Order 192 of the Rules of Procedure (RoP) was executed: on 2 April 2025, the Court Expert and the relevant bailiffs gained access to Xelom's registered office and operational premises. In accordance with Order 192 RoP, a snow groomer (serial number 127348687) was also seized. The vehicle is now being held at the warehouse in Bolzano, Via Agostini No. 2 (Xelom's operational headquarters).
4. Once proceedings on the merits had commenced, Prinoth emphasised in its Statement of Claim that crucial items of evidence had been excluded from the scope of Order 192 RoP, such as:
 - the software installed on Xelom's snow groomer (point 3.a.v of the Appeal 192 RoP);
 - commercial documentation such as contracts, quotations, purchase orders, etc. (point 3.a.xii of the 192 RoP Application);
 - the measurement of the weights on the snow groomer's wheels using a crane and load cell (point 8 of the Appeal 192 RoP);
 - the electrical/electronic circuit diagram of the entire snow groomer (see point 3.a.iii of Appeal 192 RoP);
 - the 3D CAD model of the vehicle (see point 3.a.vi of Appeal 192 RoP), providing only certain screenshots;
 - the service and maintenance manual and protocols and/or validation tests (see point 3.a.vii of Appeal 192 RoP).

In particular, Prinoth argued that:

- (i) with regard to European Patent '436, it has been proven that the Xelom Snow Cat literally infringes at least claims 1, 3, 4, 8, 9, 11, 12 and 16 of Prinoth's European Patent '436. However, in the absence of the software or at least the control logic (how chart), Prinoth is unable to prove infringement of claims 2, 7 and 15 of EP '436;
- (ii) As regards patent EP 159, the claimant was not permitted to carry out any measurements using a crane and load cell and/or any other instrument to

measure the weight distribution across the various wheels and/or axles: none of the documents found or the information provided by Xelom's technicians proved sufficient to dispel the suspicions of infringement of EP 159.

In the Statement of Claim, in particular, Prinoth requested, pursuant to Rules 170–190 of the Rules of Procedure (RoP), further evidence to be taken subject to the adoption of:

- (i) an order for the production of the following documents (see Rules 170.2(c) and 190 RoP):
 - the software installed in the control units controlcontrol units;
 - the executable file(s) ('firmware'), the configuration files and, where available, the source code or the technical ;
 - flowcharts, functional specifications, technical manuals, or other documentation that describes the logic of operation;
 - the circuit circuit electrical/electronic of the Xelom Snow Cat;
 - the model CAD of the vehicle in three-dimensional ;
 - the manual service serviceand maintenance for theXelom Snow Cat; the protocols and/or the results of tests from ;
 - commercial documentation such as contracts, quotations, purchase orders and/or hire orders and/or for demo and/or for loan;
- (ii) an order for the inspection of a physical object (see Rule 170.2(f) of the Rules of Procedure) concerning:
 - the Xelom snow groomer subject to seizure, requiring the presence of the appointed technical judge and/or the technical adviser who may be appointed;
- (iii) an order to conduct experiments (Rules 170.2 (g) and 201 RoP) concerning:
 - the measurement of the weight borne by each individual wheel of Xelom's snow groomer, in the presence, where necessary, of the technical judge to be appointed and/or the technical expert.

5. In its Statement of Defence, Xelom emphasised that:

- 1. the list of evidence requested by Prinoth extends, in part, to items that had already been refused in the *pre-trial* order, as they were deemed irrelevant to the scope of protection of the patents in question and/or, during the expert proceedings, were considered superfluous by the Court Expert and in consultation with the parties' legal representatives
- should the production order requested by Prinoth be granted in whole or in part, Xelom has requested that:
 - (i) safeguard, *pursuant to* Rule 262A of the Rules of Procedure, the protection of Xelom's confidential information, including that contained therein;
 - (ii) appoint a Court Expert to personally direct and carry out the authorised operations, ensuring that these are not carried out by a representative of the claimant company;
 - (iii)** authorise a single inspection of the vehicle, excluding its dismantling and reassembly;
 - (iv) carry out the operations as quickly as possible, in order to secure the release of the Snow Cat;
 - (v) to charge the claimant with all costs relating to the request for inspection of the vehicle and the carrying out of tests on it.

6. During the written proceedings, on 27 November 2025, Xelom filed a Statement of Defence with Counterclaim for Revocation, disputing the allegation of infringement and bringing a counterclaim for the invalidity of the patents in question pursuant to Rules 24, 25 and 26 of the Rules of Procedure.
In particular, Xelom argued that EP '436 and EP 159 were invalid, raising numerous objections regarding novelty and inventive step and, with regard to EP 159, also insufficient description.
7. On 27 January 2026, Prinoth filed the Defence to the Counterclaim for Revocation, Reply to the Statement of Defence, and Application to Amend the Patent, simultaneously filing, as a subsidiary claim to the determination of the invalidity of the asserted patents, *an application to amend the patent* pursuant to Rule 30 of the Rules of Procedure (RoP). This application comprised 5 *auxiliary requests* (hereinafter 'AR') in respect of EP '159 and 6 ARs in respect of EP '436.
8. Against each of these ARs, on 26 March 2026, in its Defence to the Application to Amend the Patents, Reply to the Defence to the Counterclaim for Revocation and Rejoinder to the Reply to the Statement of Defence pursuant to Rule 29(R) of the Rules of Procedure, Xelom set out numerous challenges to validity, numbering over 100.
9. Following the written procedure, the Judge Rapporteur, having consulted the Panel and in the exercise of his case management powers, scheduled a hearing to examine, amongst other matters, the requests for evidence put forward by Prinoth and to invite the parties respectively to reduce the challenges to validity in respect of Xelom and the counterclaims in respect of Prinoth.

Reasons for the order

The requests for evidence regarding the interference of EP159

Physical inspection and conduct of experiments

10. Prinoth's request for further investigation, concerning the physical inspection and the experiment aimed at measuring the weight borne by each individual wheel of the seized Xelom snow groomer, appears justified.
11. In this regard, Xelom's objections are not convincing. Indeed,
 - (i) the only document found in this regard during the execution of the order for the preservation of evidence does not appear relevant according to the Court Expert (see p. 7, doc. 32 of the applicant's submission):

A domanda sulla distribuzione dei pesi, il sig. [REDACTED] mostra allo scrivente un documento preparatorio del maggio 2023 (ePowertrac_Torsion_spring_of_Snowcat_v1.1.pdf) relativo ad alcune simulazioni, da cui si rileva la seguente distribuzione di forze sugli assi:

Assale	Forze	Posizione
5	33%	posteriore
4	28%	
3	14%	
2	11%	
1	15%	anteriore

Tali forze sono calcolate in una situazione di (i) pala e fresa montate e leggermente sollevate, (ii) carico del veicolo con una massa di 500 kg sulla piattaforma disposta posteriormente alla cabina, dunque, non in assenza di carico. Inoltre, si verifica visivamente che la distribuzione delle forze non è perfettamente uguale a seconda che si prenda la misura sulla ruota destra o sinistra, ciò in parte a causa di alcuni errori di calcolo. Tali dati, infatti, sono frutto di studi di sviluppo del veicolo e non di misure con celle di carico.

- (ii) the cost of the measurement and the practical difficulties involved in carrying it out do not negate the necessity and proportionality of the measure required to establish or rule out the interference.
12. It should also be noted that the evidence was not rejected by the Court in the order granted *ante causam* on the grounds that it was superfluous or inadmissible, but because it was deemed “*particularly intrusive and not immediately relevant to the purpose of the ex parte measure*”.

On the procedures for carrying out the inspection and the judicial experiment

13. Xelom requests that the weighing be carried out by a Court Expert, using the most suitable means identified by the latter (as weighing by crane is not feasible), within a very short timeframe, employing the most appropriate measures to protect its confidential information, with all associated expenses and costs to be borne by Prinoth.
14. Prinoth has raised no objection in this regard.
15. The Court considers that, in light of Rules 170.2(f) and 170.2(g) and Rule 201 of the Rules of Procedure (RoP), it is most appropriate to:
- (i) to allow the Court Expert to proceed in the manner deemed most appropriate, including the hire of the necessary equipment (for example, an overhead crane to lift the machinery – where such equipment is not made available by Xelom – and load cells for weighing) and assessing whether it is necessary to dismantle the vehicle in order to draw up a comprehensive report on the matter, with a view to measuring the weight borne by each individual wheel of the seized Xelom snow groomer;
 - (ii) to allow access to the vehicle for the minimum time strictly necessary. Having heard the parties and taken into account the time required to hire the necessary equipment referred to in point (i) above, as well as the closure of Xelom’s plant during the month of August, it has been agreed to carry out the measure between 7 and 21 September 2026: for the purposes of specifying the period more precisely, the Judge Rapporteur considers that this period should be defined as the days between 7 and 18 September 2026.
 - (iii) The costs – to be paid in advance – to the third parties from whom the technical equipment will be acquired shall be borne – in advance – by Prinoth upon request by the Court Expert;
 - (iv) the venue for the inspection and the judicial experiment is Xelom’s premises in Bolzano, Via Agostini No. 2, where the vehicle was seized;
 - (v) order, in order to protect Xelom’s confidential information, that the inspection and the judicial experiment may be attended, on Prinoth’s behalf, by the individuals forming the confidential group already established prior to the proceedings, together with Mr GianMarco Ponzellini, as requested by Prinoth’s defence during the hearing and to which Xelom’s defence raised no objection.
16. Following the conclusion of the judicial examination, the vehicle subject to seizure may be released, as requested by Xelom and as confirmed by Prinoth during the hearing.

Preliminary requests regarding the interference of EP436

Regarding the request for the production of the software

17. Prinoth requested the production of the software, which it considers necessary as it contains the operational logic by which the control system: (i) calculates the total flow requirement; (ii) determines the command for the variable-displacement pump according to the requirement; (iii) compares this requirement with the maximum flow rate; and (iv) manages, where necessary, the reduction of flow rates to the actuators/accessories should the total demand exceed the pump's capacity (see the provisions of claim 7 of EP '436).

And this is set out in the source code, since *'The mere production of the software's binary files ("firmware") would not allow for an intelligible understanding of the control system's operating modes and logic, as such files are **often** compiled and/or protected by encryption'*.

18. In this regard, Xelom emphasised:

- (i) the sufficiency of the documents seized and the Court Expert's report, particularly given the high level of detail in the hydraulic diagram, which is sufficient to reconstruct the vehicle's operation;
- (ii) the exclusion of the order to preserve such evidence from the scope of the measure;
- (iii) the irrelevance of these elements to EP '436. The opposing patent relates exclusively to hardware components – in particular the presence of a variable-displacement pump and its control based on the required flow – and does not cover any software or electronic aspects: therefore, access to the vehicle's programmes would not be relevant to *the issue in dispute*.

19. The Court, on the contrary, considers – as correctly pointed out by Prinoth – that only the examination of the software contains the operating logic of the control system of the machinery at issue in relation to the aspects for which verification was requested and indicated in point

No. 17.

The Court-appointed expert, too, in his report (see page 6, Doc 32), has specified that it is precisely the control unit that calculates the flow requirement and controls the pump, confirming that it is the software of that control unit which illustrates its operation in detail. In other words, the software analysis makes it possible to ascertain – directly – whether the control unit calculates the total flow rate requirement or whether it 'modulates the flow rate of the variable-displacement pump according to the highest pressure (and not the total pressure)'.

On the procedures for producing the software

20. During the hearing, in light of the principle of proportionality, the Judge Rapporteur asked Xelom whether it was willing to voluntarily produce the functional specifications and/or technical documentation provided by the software manufacturer, on a confidential basis and limited to those parts describing the operating logic of the control system, in order to address the issues set out in point 17.
21. Xelom's defence confirmed, during the hearing, that it was in possession of the software's source code and reserved the right to verify the actual availability of such documentation from its supplier, stating that, should it be available, it would be willing to produce it voluntarily.
22. Prinoth emphasised the need to verify that this documentation or the source code does indeed correspond to the software used on the seized snowcat, as it is common for there to be different versions of the same software.

23. The Court therefore considers it appropriate:

- (i) to allow Xelom to hand over the technical documentation referred to in paragraph 20 to the Court Expert, Mr Di Bernardo, during his visit to the premises in Bolzano, Via Agostini No. 2, for the purposes of inspection and judicial examination;
- (ii) in any event, to order that a copy be made of the source code of the software used on the seized 'Gatto di Neve', which Xelom has stated it has in its possession. This is to be carried out by the **Court Expert**, Mr Di Bernardo, at the same time and on the occasion of his visit to the premises in Bolzano, Via Agostini No. 2, as previously arranged for the purposes of the inspection and judicial experiment;
- (iii) order that the Court Expert, Mr Di Bernardo, file any documentation voluntarily submitted by Xelom and the copy of the source code with the Registry of the Local Division within the time limit specified in the operative part, together with a report on the operations carried out.
- (iv) For the purpose of examining the material referred to in point (iii) and for the purpose of answering the questions referred to in point (V), Mr Alessandro Borra, an engineer, is appointed as the IT Court Expert:
- (v) He is hereby tasked with answering the following question.
"The Court Expert is requested to *explain* the operating logic of the control system and, in particular:
 - *it calculates the flow rate requirement of the machinery's hydraulic unit,*
 - *determines the control signal for the variable-flow pump based on the required flow rate;*
 - *compares this requirement with the maximum flow rate;*
 - *manages the reduction of flow rates to the actuators/accessories should the total demand exceed the pump's capacity (see the provisions of claim 7 of EP '436)''*
- (vi) in order to protect Xelom's confidential information, it is stipulated that the examination of the documentation and/or source code referred to in point (iii) shall take place:
 - a. in a first stage, solely through any documentation provided by Xelom;
 - b. in a second stage, where the first stage referred to in point (a) has not enabled the question to be answered, by examining the source code in accordance with the following timetable:
 - initially only by the Court Expert and the parties' technical consultants, in order to select the part of the source code necessary to answer the question. To this end, the parties shall be given a time limit for appointing a technical consultant competent in IT matters within the time limit specified in the operative part, by filing such appointment with the Court Registry,
 - subsequently, also by the confidential panel on the Prinoth side, already constituted prior to the commencement of proceedings, to which must be added Mr Gianmarco Ponzellini, an engineer, and the expert witness specialising in IT matters, mentioned above and to be appointed within the time limit specified in the operative part.On the Xelom side, the persons indicated in point 2.6 of the operative part may participate in the proceedings, in a composition that is equivalent and symmetrical to that of the Prinoth-side panel.
- (vii) Set a deadline for Dr Alessandro Borra to file his report and for the parties to submit comments as set out in the operative part.

Regarding the request for the production of further technical documentation (for EP'436)

23. Prinoth has also requested the production of further technical documentation, specifically:
- (i) the electrical/electronic circuit diagram of the Xelom Snow CAT;
 - (ii) the 3D CAD model of the vehicle;
 - (iii) the service and maintenance manual for the Xelom Snow CAT;
 - (iv) the protocols and/or results of validation tests.

24. On this point, Xelom objected that *“the decision as to which documentation to gather during the enforcement of the order was made by mutual agreement between the parties, in the presence of the court-appointed expert, and refers in paragraph 157 to numerous documents already gathered; to admit further documentary evidence relating to documents already requested during the interim relief proceedings would constitute an unjustified duplication of evidence”*.

25. The Court concurs with the position expressed by Xelom.

Indeed, the relevant application appears too broad and general to be granted. This is without prejudice to any different assessments in subsequent stages.

Regarding the request for the production of commercial documentation

26. Prinoth has also requested the production of commercial documentation from Xelom (for example, contracts, quotations, purchase orders and/or hire orders and/or demo orders and/or loan agreements).

27. In this regard, the Court agrees with Xelom’s position, since the information requested by Prinoth relates solely and exclusively to the stage of any quantification of damages, which is contingent and subsequent to the current proceedings.

The relevant application must therefore be dismissed.

The Court experts

28. Pursuant to Rules 185 and 186 of the Rules of Procedure (ROP), the Court notes that the court-appointed experts named herein possess specific expertise, each in their respective fields, aimed at conducting the judicial expert assessment: Mr Antonio Di Bernando in relation to engineering matters, and Dr Alessandro Borra in relation to the examination of the software, in accordance with the timetable and procedures already specified. These experts, who are recognised consultants to the Office at the National Court, also offer guarantees of independence and impartiality;

They must be granted a period within which to accept the appointment, in accordance with the provisions of the Rules of Procedure.

29. The Court has already informed the parties during the hearing of the appointment of Mr Antonio Di Bernardo; as regards Dr Alessandro Borra, the parties must be allowed to raise any objections within the time limit specified in the operative part.

30. The Court Experts are reminded of their duties under Rule 186 of the Rules of Procedure (RoP), which is hereby incorporated in full.

The Office’s request to reduce the number of validity challenges and auxiliary requests

31. The Court reiterates:

- the ‘front-loaded’ principle (see, amongst many others, UPC CFI 240/2023, Milan Local Division, 17 December 2024; UPC CFI 263/2023, Milan Central Division, 5 April 2024; Central Division of Munich, 25 July 2026, CFIC 252/2023, according to which *‘the front-loaded nature serves the*

principles of fairness and equity by preventing a party (and the Court) from being confronted with and having to react to new evidence and arguments unreasonably late in the proceedings’);

- Rule 30.1.(c) of the Rules of Procedure (RoP), the final clause of which stipulates that “*the proposed amendments, if conditional, must be reasonable in number in the circumstances of the case*”,

- the UPC case law on the need for validity challenges to be limited to a reasonable number (see Milan Central Division, 23 October 2025, CFI 497/2024), which specified as follows: “*An assessment based on a maximum number of different documents to challenge novelty and to argue for lack of inventive step is indeed appropriate. The grounds for invalidity not identified by the party challenging the patent as the (most) promising will not be considered on the merits because, where the party submits a number of grounds for invalidity that appear unmanageable by the Court in accordance with the principles of proportionality (point 3 of the preamble) and speed (point 7 of the preamble), and that same party is unable to restructure some of the arguments in such a way as to enable the Court to organise its time for the efficient management of the proceedings, it must be assumed that if the (most) promising arguments, following the Court’s assessment, do not affect the validity of the claim(s), the others would not have done so either. Of the approximately 50 invalidity arguments, more than 12 ‘added matter’ arguments, 3 novelty grounds, 1 insufficiency ground, and 6 different lines of argument for 30 inventive step grounds (and around 15 prior art documents); a figure of three grounds per claim is preferable*”

EP’159

32. It should be noted that in the present case, with regard to EP

159: Prinoth raised five grounds of opposition;

Xelom raised:

- (i) as regards the claims as granted (Main Request):
 - with regard to claim 1, 20 grounds of opposition, including 1 for insufficient description (common to all claims), 4 for lack of novelty and 15 for lack of inventive step;
 - against claim No. 2, one ground of opposition based on D2;
 - against claim No. 3, one ground of opposition based on D3;
- (ii) with regard to the Amended Claims:
 - against AR No. 1: 12 objections, including 1 for matter not disclosed, 1 for insufficient description and 10 for lack of inventive step;
 - against AR2: 4 objections, including 1 for added matter, 1 for insufficient description and 2 for lack of inventive step;
 - against AR3: 3 objections, including 1 for insufficient description and 2 for lack of inventive step;
 - against AR4 and AR5: one ground of insufficiency of description.

33. Taking into account the circumstances of the specific case and the arguments put forward by the respective defences on this point – to which full reference is made here – with regard to EP 159, the parties are respectively invited by the Court:

a. as regards Prinoth, to reduce the number of ARs to 3;

b. as regards Xelom, to limit the objections:

- against the MR, in addition to the insufficient description, to 3 objections relating to novelty and 3 relating to inventive step, noting that its choice may need to take into account a possible issue of admissibility regarding the new objections based on D5/D28 and D29;

- against claims 1 to 5, in addition to the added subject-matter and the insufficient description, to 3 novelty objections and 3 inventive step objections, noting that its decision may take into account a possible issue regarding the admissibility of the new objections based on D5;

EP'436

34. With regard to EP '436, the objections raised by Prinoth and Xelom's validity challenges are summarised briefly below.

35. Prinoth has proposed six amendments, comprising changes to the description and the claims, which are, in principle, admissible under Rule 30.1(a): *"the proposed amendments to the claims of the patent concerned and/or the specification"*.

36. Xelom has proposed:

- a. with regard to the MR:
 - against claim 1, 20 objections (including 15 relating to novelty and 4 relating to inventive step);
 - against claim 2, 12 objections (of which 3 relate to inventive step);
 - against claims 3–4, 8 objections (there are no objections regarding inventive step);
 - against claim No. 5, 2 objections (there are no objections relating to inventive step);
 - against claim No. 6: 6 objections (of which only one involving inventive step is substantiated);
 - against claim No. 7, 5 objections (1 of which is argued to lack an inventive step);
 - against claim No. 8, 9 objections (in addition to the objections regarding novelty, 1 regarding inventive step);
 - against method claims Nos. 9–17, the same objections are raised.

b. With regard to the ARs, Xelom raises the following objections:

- against AR1: 42 objections (of which 1 relates to added matter, 1 to lack of clarity, 1 to insufficient description, 9 to novelty and 30 to inventive step);
- against AR2: 36 objections (of which 1 relates to added matter, 1 to lack of clarity, 1 to insufficient description, 5 to novelty and 32 to inventive step);
- against AR3: 16 objections (including 1 relating to insufficient description, 3 relating to novelty and 12 relating to inventive step);
- against AR4: 13 objections (including 1 for insufficient description and 12 for inventive step);

- against AR5: 11 objections (including 1 for insufficient description, 1 for lack of clarity, and 9 for inventive step);
- against AR6: 8 objections (of which 1 relates to insufficient description, 1 to novelty and 6 to inventive step).

37. In the light of the principles set out in paragraph 31, having regard to the circumstances of the case and the arguments put forward on this point by the respective defence teams, to which full reference is hereby made,

(i) with regard to EP' 159:

a. Prinoth s.p.a., to reduce the number of Auxiliary Requests to 3;

b. Xelom s.r.l. to limit the objections relating to novelty and inventive step:

- against the Main Request, to raise three objections on novelty and three on inventive step, noting that its choice must take into account a possible issue of admissibility regarding the new objections based on D5/D28 and D29;
- against Auxiliary Requests 1 to 5, to three novelty objections and three objections on inventive step, noting that its decision must take into account a potential issue regarding the admissibility of the new objections based on D5;

(ii) With regard to EP' 436:

a. Prinoth s.p.a., to limit the Auxiliary Requests to 4;

b. Xelom s.r.l. to limit the objections regarding novelty and inventive step:

- against the Main Requests: 4 objections on novelty and 4 on inventive step;
- against Auxiliary Claims 1 to 6: 4 novelty objections and 4 inventive step;

noting that its decision must take into account any potential issue regarding the admissibility of new documents based on documents D21 to D27 and/or directed against features already present in the granted claims.

The parties have agreed that the submissions regarding the reduction of the Auxiliary Requests and the challenges to validity should be made after the Court Experts have filed their reports: this request, made by both parties, appears to the Court to be proportionate and justified, in light of the need to weigh up the respective defences in the light of the findings of evidence, and must therefore be granted.

UPC Approach and Problem Solution Approach

38. In order to ensure the effectiveness of the right of defence in every respect, the Court invites the parties, in the written submissions to be filed for the purposes referred to in paragraph 26, to argue on the level of inventiveness in accordance with the UPC approaches (see decisions of 25 November 2025, UPC_CoA_528/2024, UPC CoA 529/2024), in addition to the *problem-solution approach*, specifying which test of infringement by equivalence they are using.

The Court's requests

39. In order to ensure the full comprehensibility of the documentary evidence and to complete the picture, the Court considers it appropriate to invite:

- (i) each of the parties to file a typewritten version of the bailiff's report drawn up during the enforcement of the interim measure granted prior to the main proceedings;
- (ii) Prinoth:
 - to resubmit documents 6, 26, 28 and 46 to 50, which are currently illegible;
 - to file the text of EP 159 as granted, if not already filed;
 - to provide evidence of the validation in the Contracting Member States, other than Italy, of the two patents;
 - to provide evidence of the transfer of the two patents in their favour in the Contracting Member States other than Italy;
 - that the two patents are in force in the Contracting Member States.

ORDER

- 1.1. Orders that an inspection and a judicial experiment be carried out concerning the measurement of the weight and, in particular, its distribution across the various axles and on each individual wheel of the Xelom vehicle seized prior to the commencement of proceedings, assessing the need to dismantle the vehicle in order to carry out the test and answer the question;
- 1.2. appoints, for this purpose, Dr ANTONIO DI BERNARDO, whose practice is at [REDACTED] No. [REDACTED] Tel. [REDACTED], and instructing him of the obligations set out in Rule 186
RoP;
- 1.3. invites Dr ANTONIO DI BERNARDO to state by 27 July 2026 whether he intends to accept the appointment (making use of any assistant, whose name must be provided by 25 July 2026 and under his responsibility) and to carry it out in accordance with the timeframe set out below, unless there are specific circumstances preventing this, which must be reported to the Court;
- 1.4. to this end, invites Xelom s.r.l. to inform the Court by 31 July 2026 whether it has the means to lift the vehicle subject to seizure in order to proceed with the judicial test;
- 1.5. orders that the inspection and the judicial test be carried out within the period from 7 to 18 September 2026, subject to consultation by the Court Expert with the parties for the purposes of the necessary coordination, at the premises of Xelom s.r.l., in Bolzano, Via Agostini No. 2;
- 1.6. orders that the Court Expert, following consultation with the parties, shall independently procure – including by hiring from third parties – the necessary equipment to carry out the judicial experiment, such as load cells and lifting equipment for the seized vehicle (where, with regard to the lifting equipment, Xelom s.r.l. does not confirm, in accordance with point 1.4, that it has such equipment available);
- 1.7. authorises the presence of the following individuals during the judicial experiment:
 - (a) the representatives of Prinoth S.p.A. authorised to represent the company before the Unified Patent Court pursuant to Articles 48.1 and 48.2 of the UPCA and specifically named in these proceedings, namely Messrs Bocca, Grassani and Scalvini, and Messrs Eccetto and Cicchetti;
 - (b) other professionals or associates of the law firms BonelliErede, Gatti Pavesi Bianchi Ludovici, and Studio Torta who are assisting the authorised representatives of Prinoth S.p.A. in these proceedings, subject to the applicant providing their names;
 - (c) Engineer Alberto Paoletti;

(d) Engineer Gianmarco Ponzellini;

1.8. orders the Court Expert to file their report by 25 September 2026;

1.9. orders that the parties be granted access to the expert's written report and its annexes from 29 September 2026 at 11.00 am, at the offices of the Sub-Registry of the Milan Local Division, in the presence of a registrar;

1.10. sets a deadline for the parties to file any observations by 31 October 2026;

1.11. orders that the full costs of hiring the equipment necessary to carry out the judicial experiment shall be borne by Prinoth spa, which is required to pay the relevant advance upon notification by the Court Expert, directly to the lessor of the equipment necessary to carry out the judicial experiment;

1.12. acknowledges that the vehicle subject to seizure may, following the inspection and weighing, be released from seizure and returned to the possession of Xelom s.r.l.;

2.1. requests that Xelom s.r.l. submit, during the access for the purposes of the inspection and test referred to in point 1, the functional specifications of the software installed in the control units and the technical documentation provided by the software manufacturer (if available) relating to flow rate requirements, to the Court Expert, Engineer ANTONIO DI BERNARDO;

2.2. orders that the Court Expert, Engineer ANTONIO DI BERNARDO, during the access for the purposes of the inspection and testing referred to in point 1, possibly with the assistance of an aide, shall obtain the source code of the software installed in the control unit of the machinery subject to seizure and relating to flow rate requirements, and shall ensure that it is filed with the Registry together with any functional specifications and technical documentation for the software provided by Xelom s.r.l. in accordance with point 2.1.

2.3. appoints Dr ALESSANDRO BORRA, whose practice is situated in [REDACTED] [REDACTED] [REDACTED] to examine the functional specifications and technical documentation of the software and/or the relevant source code, as referred to in points 2.1 and 2.2, and hereby reminds him of the obligations set out in Rule 186 of the Rules of Procedure;

2.4. invites Dr ALESSANDRO BORRA to state by 27 July 2026 whether he intends to accept the appointment and to carry it out in accordance with the timeframe set out below (subject to the possibility of an extension as further specified in point 2.8.) and to raise any objections to his appointment by 31 July 2026;

2.5. authorises each of the parties to appoint their own technical expert with IT expertise, notifying the Registry by 7 September 2026;

2.6. orders that Dr ALESSANDRO BORRA, having first accessed the court file, shall respond to the question put by the Court in accordance with the following stages:

- (i) in the first stage, to obtain any documentation submitted by Xelom s.r.l. referred to in point 2.1., filed with the Court Registry from 26 September 2026, and to keep it confidential.

At this stage, the appointed Court Expert and the parties' technical experts shall examine only the documentation submitted by Xelom s.r.l. as referred to in point 2.1. and shall assess the feasibility of answering the questions set out in point 2.7.;

- (ii) if so, the copy of the source code shall be returned to Xelom s.r.l. without being examined, pending an order from the Court;
 - (iii) in a second stage, and only if it is impossible to provide an exhaustive answer to the question in accordance with the procedures set out in point (i), the Court Expert and the parties' technical consultants – having first obtained the source code from the Court Registry – shall examine the source code, selecting only the portion necessary to answer the question referred to in point 2.7;
 - (iv) in a third stage, the Court Expert shall make available only that portion of the source code
 - :
 - on the part of Prinoth S.p.A., to the confidential group as indicated in point 1.7, as well as to a CTP appointed in accordance with point 2.5.
 - on the part of Xelom s.r.l.:
 - to its representatives authorised to act before the Unified Patent Court pursuant to Articles 48.1 and 48.2 of the UPCA and specifically identified in these proceedings;
 - to other professionals or associates of the law firms and patent agents assisting Xelom's authorised representatives in these proceedings, subject to Xelom notifying the Court of their names;
 - to two party-appointed technical experts competent in the fields of mechanics and/or electronics;
 - to one party-appointed technical expert competent in the field of information technology,
- such court-appointed technical experts to be named by 7 September 2026, with notification to the Court Registry;

2.7. orders that the Court Expert Dr ALESSANDRO BORRA, with the assistance, if necessary, of the Court Expert Eng. ANTONIO DI BERNARDO, shall, where necessary, answer the following question: Let the Court Expert explain the operating logic of the control system and, in particular:

- (i) *it calculates the flow rate requirement of the machinery's hydraulic unit;*
- (ii) *determine the control signal for the variable-flow pump based on the flow requirement;*
- (iii)** *compares this requirement with the maximum flow rate;*
- (iv)** ***manages** the reduction in flow rates to the actuators/accessories should the total demand exceed the pump's capacity,*

2.8. Orders the Court Expert to file their report by 20 October 2026 (unless an extension is strictly necessary, in which case authorisation must be sought from the Court);

2.9. The Court grants the parties until 31 October 2026 to submit any observations.

3.1. The parties are invited by the Court:

- (i) with regard to EP' 159:
 - a. Prinoth S.p.A., to reduce the number of auxiliary requests to three;
 - b. Xelom s.r.l. to limit the novelty and inventive step objections:
 - against the Main Requests, to limit the number of novelty and inventive step arguments to three each, noting that its choice must take into account a possible issue regarding the admissibility of the new arguments based on D5/D28 and D29;
 - against Auxiliary Requests 1 to 5, to three novelty objections and three objections on inventive step, noting that its decision must take into account a potential issue regarding the admissibility of the new objections based on D5;

- (ii) With regard to EP' 436:
 - a. Prinoth s.p.a., to limit the Auxiliary Requests to 4;
 - b. Xelom s.r.l. to limit the objections regarding novelty and inventive step:
 - against the Main Requests: 4 objections on novelty and 4 on inventive step;
 - against Auxiliary Claims 1 to 6: four novelty objections and four objections on inventive step;noting that its decision must take into account any potential issue regarding the admissibility of the new documents based on documents D21 to D27 and/or relating to features already present in the granted claims.
- 3.2. For the purposes referred to in point 3.1, it sets a deadline for the filing of written submissions:
 - (i) until 31 October 2026 for Prinoth S.p.A. to amend the Auxiliary Requests, including by means of a simple reference to the relevant paragraphs of the briefs previously filed;
 - (ii) until 13 October 2026 for Xelom s.r.l. to amend its validity challenges, including by simply referring to the relevant paragraphs of previously filed written submissions;
 - (iii) by 16 November 2026 to Prinoth S.p.A. for a reply;
 - (iv) by 16 November 2026 to Xelom s.r.l. for a rejoinder;
- 3.3. in the written submissions referred to in point 3.2, invites the parties to argue the inventive step in accordance with the *UPC approach* (in addition to the *problem-solution approach* used by the parties), specifying which test of infringement by equivalence they are using;
- 4. orders the parties to provide a typed version of the report drawn up by the Judicial Officer in execution of the order for the preservation of evidence granted *ante causam* by 31 October 2026;
- 5. requires:
 - (i) Prinoth S.p.A. by 31 October 2026:
 - (i) to file the text of EP '159 as granted, if not already filed;
 - (ii) to provide evidence of the validation in the Contracting Member States, other than Italy, of the two patents;
 - (iii) to provide evidence of the assignment of both patents to Prinoth in the Contracting Member States other than Italy;
 - (v) to provide evidence that the two patents are in force in the Contracting Member States;
 - (vi) to resubmit documents 6, 26, 28, 46 and 50, which appear to be illegible;
 - (ii) Xelom s.r.l. to submit any observations by 16 November 2026;
- 6. rejects all further requests for further evidence from Prinoth S.p.A. on the grounds set out in the operative part;
- 7. schedules the Interim Conference to be held by videoconference via a link to be provided by the Court Registry on 25 November 2026 at 10.30 am;

8. schedules the Oral Hearing to take place in person on 26 January 2027 at 10.30 am, at the Milan Local Division of the Unified Patent Court;

9. instructs the Registry to carry out the necessary formalities, in particular to notify the appointed Court Experts, Mr ANTONIO DI BERNARDO and Dr ALESSANDRO BORRA, of this order.

So decided in Milan, on 21 July 2026

The Reporting Judge

Alima Zana

ALIMA
ZANA



Digitally signed
by ALIMA ZANA
Data
21 July 2026
15 0:27 +02'00'

